REMARKS

Claims 1 and 2-41 are active in the present application.

At the outset, Applicants wish to thank the Examiner for the indication that the previous anticipation rejections over Janecka et al, Baudoin et al, and Fukuda et al have been withdrawn (see paragraphs 2-4 of the Office Action dated July 6, 2005). Applicants also wish to thank the Examiner for the indication that Claims 3 and 20-23 remain allowable (see paragraph 8 of the Office Action dated July 6, 2005). Applicants also request withdrawal of the outstanding rejections in view of the amendments above.

The rejections of: (a) Claim 1 under 35 U.S.C. §102(b) and/or under 35 U.S.C. §103(a) over Iwama et al; and (b) Claim 24 under 35 U.S.C. §102(b) and/or under 35 U.S.C. §103(a) over Isler, are obviated by amendment.

Applicants have amended the claims to more specifically define the compounds or peptides of Formula (1). Specifically, Claims 1 and 24 have been amended to define the amino acid side chain at position R^4 as being a "basic amino acid side chain," while the amino acid side chain at position R^7 has been defined as being a "neutral amino acid having a hydrophobic side chain."

In view of the foregoing amendment, Applicants submit that neither Iwama et al nor Isler disclose or suggest a compound falling within the scope of the presently claimed invention. The standard for determining anticipation requires that the reference "must teach every element of the claim" (MPEP §2131). Therefore, the failure of Iwama et al or Isler to specifically disclose or suggest a compound or peptide within the scope of the claimed invention would necessarily make these references fail to anticipate the claimed invention.

Moreover, Applicants submit that the asserted art of record cannot even support a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation... to modify the reference... Second, there must be a reasonable expectation of success. Finally, the prior art reference... must teach or suggest all the claim limitations." (MPEP §2142) Applicants note that neither Iwama et al nor Isler provides any motivation or suggestion to modify their disclosures to arrive at the claimed invention.

In view of the foregoing, Applicants request withdrawal of the rejections over Iwama et al and Isler. Acknowledgment to this effect is requested.

The rejection of Claims 1, 4-19, and 24-41 under 35 U.S.C. §112, first paragraph (written description), is obviated in part by amendment and traversed in part.

The Examiner's criticisms of the claims as lacking sufficient written description fall into two categories: (A) an allegation that the specification fails to disclose a genus of variants for the compounds of Formula (1) having inhibitory activity against MSH and their use as an active ingredient in a MSH inhibitory composition, a whitening agent, an immunofunction controlling agent, an appetite controlling agent, or cosmetic preparation (see page 3, lines 19-22 of the Office Action mailed July 6, 2005), and (B) an allegation that the specification fails to describe how to identify an active amino acid, dipeptide or tripeptide compound within the scope of Formula (1).

In regard to criticism (A), Applicants direct the Examiner's attention to the painfully detailed description in the specification at pages 5 and 8-16 of the genus of variants for the compounds of Formula (1). Applicants remind the Examiner that MPEP § 2163.02 states:

> An objective standard for determining compliance with the written description requirement is, "does the description clearly allow

> persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gostelli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Applicants submit that the specification at pages 5 and 8-16 provides a more than adequate description to allow the skilled artisan to recognize what has been invented and what is claimed is adequately described in the specification within the meaning of 35 U.S.C. § 112, first paragraph. Therefore, Applicants submit that the genus of compounds of Formula (1) is in full compliance with 35 U.S.C. §112, first paragraph.

Turning to criticism (B), Applicants direct the Examiner's attention to page 16, line 12 to page 19, line 2, which provides a full and detailed description of how to identify an *active* amino acid, dipeptide or tripeptide compound within the scope of Formula (1). Further, pages 19-24 describe how the skilled artisan would prepare compositions containing the compounds meeting the claimed activity limitation (see Claim 4).

Moreover, Applicants direct the Examiner's attention to pages 25-43 in which Applicants have exemplified several synthetic methods to produce compounds of Formula (1) and methods by which the activity of the same may be ascertained. In particular, Applicants wish to now Test Examples 1, 2, and 4 by which the skilled artisan may readily identify functional compounds. Again, the Examiner is reminded of the standard for determining compliance with the written description requirement set forth in MPEP § 2163.02. In view of the foregoing, Applicants submit that in view of the extensive description in the specification the skilled artisan would be able to readily recognize that which they have invented and claimed.

In view of the foregoing, Applicants submit that the skilled artisan would readily appreciate the scope of the claims as presently presented. As such, Applicants request withdrawal of this ground of rejection.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

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